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Scott Montgomery

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EXAMINER

MURDOUGH, JOSHUA A

ART UNIT

PAPER NUMBER

3621

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/990,341	<b>Applicant(s)</b> MONTGOMERY ET AL.	
	<b>Examiner</b> JOSHUA MURDOUGH	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 85-87, 90, 93, 97-102, 104, 124-126, 128, 131, 138-140 and 143-147 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-87, 90, 93, 97-102, 104, 124-126, 128, 131, 138-140, and 143-147 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 October 2009 has been entered.

### ***Acknowledgements***

2. This action is responsive to Applicants' above noted RCE and associated amendments received 6 October 2009.
3. This action has been assigned paper number 20091214 for reference purposes only.
4. Claims 85-87, 90, 93, 97-102, 104, 124-126, 128, 131, 138-140, and 143-147 are pending.
5. Claims 85-87, 90, 93, 97-102, 104, 124-126, 128, 131, 138-140, and 143-147 have been examined.

### ***Claim Objections***

6. Claims 86 and 126 are objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claims. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

7. The test for whether a claim is a proper dependent (“Infringement Test”) is set forth in MPEP § 608.01 III. The Infringement Test is whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

8. In this instance, claim 85 from which claim 86 depends recites “a unique tracking number.” Unique means that something is the only one. See the definition of “unique” below. Claim 86 recites “the unique tracking number is unique within the USPS for at least one year.” Therefore, in claim 86, the number can be reused a long as there is a year between uses. However, in claim 85 the number can never be reused. Thus, claim 86 can be infringed by a method where the number is not truly unique, but is only unique over a period of time greater than one year. This method would not infringe the parent claim 85.

9. Therefore, claim 86 is objected to for being an improper dependent claim because it can be infringed without infringing claim 85 from which it depends.

10. Claim 126 contains a similar limitation and is objected to for the same reason.

### ***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 124-126, 128, 131, 138-140, and 143 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 124 recites “data processing circuitry that executes on the postage-issuing computer system” which renders the claim indefinite. One of ordinary skill in the art would not understand what the structure is of executable circuitry. Typically, software is executed by circuitry such as a microcontroller, RAM, and a motherboard. Throughout Applicants’ specification (See pages 28, 30, 37, 38, 52, 55, 57, 64, 70, and 72) the data processing circuitry is correlated to a “Central Processing Unit (CPU).” Therefore, when applying the prior art, the “data processing circuitry” has been interpreted as a “CPU.” To overcome this rejection, Applicants are advised to claim the execution of software instead of execution of circuitry. Applicants are reminded that no new matter may be added. If Applicants have any questions about this, they are invited to contact the Examiner.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 85-87, 90, 98-102, 104, 124-126, 128, 138, 140, 143, and 145-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer (US 6,427,021) in view of Official Notice.

16. As to claims 85, 124, and 147, Fischer shows:

- a. A method for detecting postage fraud using an indexed lookup procedure, comprising:
- b. receiving, at a postage-issuing computer system (Figure 4), a request for a postage transaction from an end user computer (Figures 7A-7D);
- c. allocating a unique tracking number to the requested postage transaction (“unique identifier” C 3, LL 20-38), wherein the unique tracking number allocated to the postage transaction provides a mail piece tracking capability within the United States Postal Service (USPS) (the indicia it is placed in is a USPS Information Based Indicia (IBI), C 4, LL 66-67);
- d. generating (inherent to ordering printing, C 5, LL 53-60), at the postage-issuing computer system (PSD 44 is part of the system shown in Figure 4), a unique postage indicium for the requested postage transaction (printed on the mail piece, C 5, LL 53-60), wherein the unique postage indicium contains the unique tracking number allocated to the postage transaction that provides the mail piece tracking capability within the USPS (IBI, Id.);
- e. storing information for the postage transaction (elements 24 and 35, C 6, LL 35-58) in a database **55** coupled to the postage-issuing computer system (via connection 51), wherein the information stored for the postage transaction includes the unique tracking number and the unique postage indicium (the tracking identifier is contained in the IBI 24);
- f. indexing (“for each indicia number find tracking number” 916, Figure 12B) the information stored for the postage transaction in the database with the unique tracking

number allocated to the postage transaction (the tracking number is stored as an index in the database, Figure 12B);

g. retrieving the information indexed with the unique tracking number from the database (Figure 12B) and performing validation of the information (C 6, LL 35-59); and

h. transmitting, from the postage-issuing computer system, the information retrieved from the database to the USPS (via connection 53), wherein the USPS determines whether indicia on the mail piece carrying the unique tracking number is valid based on the information transmitted from the postage-issuing computer system(C 6, LL 35-59).

17. Fischer does not expressly show:

i. the retrieving of the information indexed with the unique tracking number from the database is in response to receiving a validation request received from the USPS relates to a mail piece carrying the unique tracking number; and

j. the USPS determines whether to submit the mail piece carrying the unique tracking number for delivery.

18. However, as Fischer shows the validation and retrieval of information, and because the USPS has to make a decision as to whether they are being paid for the service they are providing (if the elements in the IBI are valid, C 6, LL 35-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Fischer to have the USPS request the information in order to perform the validation, because the USPS would need the information in order to validate the data collected from the printed indicia.

19. The Examiner takes Official Notice that it is notoriously old and well known in the art to not provide a service when the payment appears fraudulent. To support this position, the

Examiner notes that because the party provides the service at a cost to the party, with the intention of making more than the cost from the purchaser, the party would not be willing to provide the service if the payment is in question. If the payment does not come through, the party would still have to pay the costs and receive nothing in return. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Fischer, to have the validity determination govern the mailing of the mail piece because if the indicia is invalid, the USPS would not get proper payment for providing the service of delivering the mail piece.

20. As to claims 86 and 125, Fischer further shows:

k. The unique tracking number is unique within the USPS for at least one year (because the identifier is unique, it is by definition unique over a shortened duration).

21. As to claims 87 and 126, Fischer further shows:

l. the information stored for the postage transaction further includes one or more of a postage amount **15**, a date **16**, a time, a service class, an optional data advance, a meter number **18**, an account number, or a destination zip code (The Examiner notes that while citations are provided for particular elements, the elements themselves do not change the method performed. Therefore, if Applicants desire full weight to be given to these elements, then reciting the use of the particular elements, is respectfully suggested.).

22. As to claims 90 and 128, Fischer further shows:



- m. applying a private key to the unique postage indicium to derive a digital signature ("the indicium includes a digital signature," C2, LL 48-50) from the unique postage indicium ("a cryptographic digital signature for the indicium," C2, LL 50-52), wherein the information stored for the postage transaction in the database further includes the digital signature derived from the unique postage indicium (IBI element No. 4, C 17, LL 54-58); and
  - n. transmitting, from the postage-issuing computer system the digital signature derived from the unique postage indicium to the USPS in response to the validation request, wherein the USPS verifies that the postage-issuing computer system generated a postage indicium carried on the mail piece in response to determining that the digital signature transmitted from the postage-issuing computer system is consistent with a digital signature derived from the postage, indicium carried on the mail piece (This has been shown for other pieces of information as set forth in the rejection of claims 85 and 124 above. The particular data being transmitted does not affect the method steps in this instance as any two pieces of data can be compared in the same manner.).
23. As to claim 98, Fischer further shows:
- o. the postage-issuing computer system receives the validation request from the USPS over a communications link connecting the postage-issuing computer system with a computer system at the USPS (While shown as elements 52, 53, and 54, the communications link is inherent to the request being made.)

24. As to claim 99, Fischer further shows:

p. the postage-issuing computer system transmits the information received from the database to the USPS over the communications link **53**.

25. As to claim 100, Fischer further shows:

q. transmitting the unique tracking number and the unique postage indicium to the end user in a format that enables the end user computer to print a one-dimensional bar code representative of the unique tracking number **27** and a two-dimensional bar code representative of the unique postage indicium **30**.

26. As to claim 101, Fischer shows as set forth in regard to claim 100 above but does not expressly show:

r. the computer system at the USPS displays the information transmitted from the postage-issuing computer system.

27. However, the Examiner takes Official Notice that it is notoriously old and well known in the art to display data processed on a computer because without displaying it, the operator cannot know what is being processed or if anything is being processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Fischer to display the information on the USPS computer system in order to allow for manual oversight.

28. As to claims 102 and 138, Fischer further shows:

s. the USPS verifies that the mail piece was sent from a trusted entity in response to the information transmitted from the postage-issuing computer system including one or more of a meter number **18** or an account number.

29. As to claim 104, Fischer further shows:

t. the postage-issuing computer system transmits the unique tracking number and the unique postage indicium to the end user computer over another communications link connecting the postage-issuing computer system with the end user computer (link between 44 and 41 in Figure 4).

30. As to claims 140, 145, and 146, Fischer further shows:

u. compare the unique postage indicium indexed with the unique tracking number in the database to a printed postage indicium carried on the mail piece (Abstract).

31. Claims 93, 97, 131, 139, and 144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer as applied to claims 85 and 124 above, and further in view of USPS Press Release #01-002.

32. As to claims 93 and 131, Fischer shows as set forth above in regards to claims 85 and 124 but does not expressly show:

- v. requesting the unique tracking number from the USPS, wherein the postage-issuing computer system requests the unique tracking number from the USPS; and
- w. receiving the unique tracking number from the USPS at the postage-issuing computer system prior to allocating the unique tracking number to the postage transaction.

33. However, USPS Press Release #01-002 shows the USPS providing tracking numbers to be placed on mail so the mail can be tracked as it flows through the automated mailstream (Paragraph 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Fischer to have the postage-issuing device request and receive a tracking number from the USPS because the mail piece will be in the USPS postal system. Moreover, having the USPS issue the number ensures that the same tracking number is not unintentionally issued by two different meters.

34. As to claims 97, 139, and 144, Fischer shows as set forth above in regards to claims 85 and 124 but does not expressly show:

- x. the unique tracking number comprises a delivery confirmation code.

35. However, USPS Press Release #01-002 shows the tracking of a mail piece through the mailstream (Paragraph 1). Thus, the tracking would also show when the mail piece has left the mailstream or delivered. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Fischer to use the tracking number as a delivery confirmation code as well, because the tracking system would already know when the mail piece had left the system.

36. As to claim 144, Fischer further shows:

y. applying a private key to the delivery confirmation code to derive a digital signature ("the indicium includes a digital signature," C2, LL 48-50) from the unique postage indicium ("a cryptographic digital signature for the indicium," C2, LL 50-52), wherein the information stored for the postage transaction in the database further includes the digital signature derived from the unique postage indicium (IBI element No. 4, C 17, LL 54-58); and

z. transmitting, from the postage-issuing computer system, the digital signature derived from the unique postage indicium to the USPS in response to the validation request, wherein the USPS verifies that the postage-issuing computer system generated a postage indicium carried on the mail piece in response to determining that the digital signature transmitted from the postage-issuing computer system is consistent with a digital signature derived from the postage indicium carried on the mail piece (This has been shown for other pieces of information as set forth in the rejection of claims 85 and 124 above. The particular data being transmitted does not affect the method steps in this instance as any two pieces of data can be compared in the same manner.).

### ***Claim Interpretation***

37. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his

interpretation of the claims.<sup>1</sup> Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- aa. ***Unique***: "1: being the only one." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

### ***Response to Arguments***

38. Applicant's arguments with respect to claims 85-87, 90, 93, 97-102, 104, 124-126, 128, 131, 138-140, and 143-147 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

40. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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<sup>1</sup> While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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